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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,775	12/20/2001	Ryo Watanabe	217399US8	6948

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EXAMINER

LEE, PHILIP C

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,775

Applicant(s)

WATANABE, RYO

Examiner

Philip C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-6 are presented for examination.

2. The specification is objected to because of the following unclear descriptions: According to the specification, page 12, lines 9-10, it is unclear what is meant by “the self port” (i.e. does it means the port that received the packet from a network segment?), page 13, line 5, it is unclear what is meant by “transformation information” (i.e., the network protocol type that is required), page 12, lines 9-11, it is unclear how the self port or the output destination port is in the status of being set up as a monitored port (i.e., a user indicating a monitored port using some type of user interface). Appropriate correction is required.

Claim Rejections – 35 USC 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Duplication of packets added with the control information and the transformation information to a designated port is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). According to the specification, page 16, lines 18-22, the forwarding processing section transfers the packet (i.e., one packet) added with the control information and the transformation information to the transfer destinations (the port #B and the port #D). It is unclear how one packet can be transferred to two destinations. It is essential to the practice of the invention to duplicate (e.g., port mirroring) the packet in order to transfer to two destinations.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The following terms lack proper antecedent basis:
 - i. the self port – claim 1.
 - ii. the received packets – claim 1.
 - iii. the self – claim 1.
- b. Claim language in the following claims is not clearly understood:
 - i. As per claim 1, lines 2-4, it is unclear how the packet is outputted “from” a port that becomes a monitoring port “to” a monitoring unit [i.e. does it means outputs packet “to” a port that becomes a monitoring port connected with a

monitoring unit?]; Lines 7-10, it is unclear how the output destination port ID be both a destination port and a monitoring port [i.e. one packet being transfer to two destination addresses]; Line 11, it is unclear what is meant by “the self port” [i.e. does it means the port that received the packet from a network segment?]; Lines 11-12, it is not clearly understood what is meant by whether the self port is in the status of being set up as a monitored port or not [i.e. does it means whether the self port is setup as a monitored port?]; Lines 12-13, it is unclear if “transformation information for transforming packets” is added to the received packet; Line 14, it is uncertain if “transformed packets” refers to the received packets in line 13 above [i.e. if transformation is not necessary, then the received packet will not be transformed packet]; it is uncertain if “the self” refers to “the self port” in line 11 above; Lines 15-17, it is not clearly understood what is meant by “when the self or the output destination port is in the status of being set up as a monitored port [i.e. does it means when the self port or the output destination port is setup as a monitored port]; Lines 18-19, it is unclear what is meant by “decides whether received packets are from the monitored port or not” [i.e. does it means decides whether received packet are from the monitored port?]; Line 21, it is uncertain if “a monitoring port” refers to “the monitored port” in line 19 above [i.e. should be “monitored port” in line 21].

- ii. As per claim 2, line 2, it is unclear what is meant by “the self port” [i.e. does it means the port that received the packet from a network segment?]; Line 3, it is uncertain if “ a monitoring port” should be “ a monitored port”.

- iii. As per claim 3, lines 3-4, it is unclear what is meant by "the self port" [i.e. does it mean the port that received the packet from a network segment?].
- iv. As per claims 5 and 6, they have the same uncertainties as claim 1 above.

Claim Rejections – 35 USC 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A program is not stored on a computer readable medium, wherein the specification cannot define a computer readable medium as a transmittal signal or carrier wave [i.e. must be a storage device].

Claim Rejections – 35 USC 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murthy et al, U.S. Patent 5,610,905 (hereinafter Murthy) in view of Jennings et al, U.S. Patent 6,425,015 (hereinafter Jennings).

9. (As interpreted by the examiner based on the best understanding of the claim) As per claims 1 and 5-6, Murthy taught the invention substantially as claimed that has a plurality of ports for mutually connecting a plurality of network segments (col. 11, lines 11-24), and outputs packets to be input to/output from a port that becomes a monitored port, from a port that becomes a monitoring port to a monitoring unit (fig. 1; col. 4, lines 51-56; col. 18, lines 23-26), wherein each of said plurality of ports comprises:

an address resolution processing section that transfers output destination port information that specifies an output destination port and a monitoring port, to a forwarding processing section (col. 7, lines 1-15; col. 9, lines 28-53; col. 22, lines 48-51), and at the same time, adds control information (col. 9, lines 44-51) and transformation information for transforming packets, to the received packets when the packet transformation is necessary (col. 9, lines 44-51) when the self or the output destination port is in the status of being set up as a monitored port when the packets have been received from said network segment (col. 22, lines 25-35);

an output processing section that decides whether received packets are from the monitored port or not when the self port is in the status of being set up as a monitoring port at the time when the packets added with the control information and the transformation information have been input from said forwarding processing section (col. 18, lines 37-39), and transforms

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the packets based on the transformation information and transmits the transformed packets to said monitoring unit when the received packets are not from the monitored port, and transmits the packets to said monitoring unit without transforming the packets when the received packets are from the monitored port (col. 22, lines 25-35); and

said forwarding processing section that transfers the packets added with the control information and the transformation information to a designated port (col. 9, lines 28-33; col. 8, lines 23-25; col. 2, lines 33-39), according to the output destination information input from said address resolution processing section (col. 22, lines 48-51).

10. Murthy did not teach that the control information contains information showing whether the self port is in the status of being set up as a monitored port or not. Jennings taught a similar invention comprises adding control information that contains information showing whether the self port is in the status of being set up as a monitored port or not (col. 4, lines 4-35).

11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Murthy and Jennings because Jennings's teaching of control information showing whether the self port is in the status of being setup as a monitored port would increase the alertness in Murthy's system by providing indication showing whether a packet is to be copied to the monitoring port in addition to being sent to its intended destination (col. 4, lines 21-25),

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12. (As interpreted by the examiner based on the best understanding of the claim) As per claim 2, Murthy and Jennings taught the invention substantially as claimed in claim 1 above. Murthy further taught wherein when the self port is in the status of not being set up as a monitoring port at the time when the packets added with the control information and the transformation information have been input from said forwarding processing section, said output processing section transforms the packets based on the transformation information, and transmits the transformed packets to the network segment (col. 7, lines 1-15; col. 9, lines 28-33; col. 22, lines 25-35).

13. (As interpreted by the examiner based on the best understanding of the claim) As per claim 3, Murthy and Jennings taught the invention substantially as claimed in claim 1 above. Jennings further taught wherein the control information includes a flag that shows a valid status when the self port has been set up as a monitored port and that shows an invalid status when the self port has not been set up as a monitored port (col. 4, lines 4-35).

14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Murthy and Jennings for the same reason set forth in claim 1 above.

15. (As interpreted by the examiner based on the best understanding of the claim) As per claim 4, Murthy and Jennings taught the invention substantially as claimed in claim 1 above.

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Murthy further taught wherein it is possible to optionally set up said monitored port and said monitoring port at said plurality of ports (col. 19, lines 10-13).

CONCLUSION

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Keeffe et al, U.S. Patent 6,785,286, disclosed a method of port mirroring on a multi-port communication device.

Bussiere, U.S. Patent 6,041,042, disclosed a system for remote port mirroring.

Sheu et al, U.S. Patent 6,310,860, disclosed a method of monitoring port of a multi-port network switch.

17. A shortened statutory period for reply to this Office action is set to expire **THREE MONTHS** from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent

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Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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